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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

33012/246/1/01

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on August 30, 2006

Signature

Typed or printed name Carolyn I. Erickson

Application Number

09/189,615

Filed

11/09/1998

First Named Inventor

Niels Gebauer

Art Unit

2168

Examiner

G. Robinson

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)

☒

attorney or agent of record. 25,645

Registration number

☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34

Signature

Wayne A. Sivertson

Typed or printed name

612-331-1464

Telephone number

8-30-06

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒

*Total of 4 forms are submitted.

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P A T E N T

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Niels Gebauer

Serial No. : 09/189,615

Examiner: G. Robinson

Filed : November 9, 1998

Group Art Unit: 2168

For : METHOD AND APPARATUS FOR PROVIDING AN AVAILABILITY
MESSAGE TO A REMOTE USER TERMINAL (Amended)

Docket No. : 33012/246/101

REASONS FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

CERTIFICATE UNDER 37 C.F.R. 1.8

I hereby certify that this correspondence is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an enveloped addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 30th day of August, 2006

By:  _____
Carolyn I. Erickson

Sir:

Claims 1-22 have been rejected under 35 U.S.C. 103(a) as being obvious over Cool ICE User's Guide Release 1.0 (hereinafter referred to as "Cool ICE") in view of U.S. Patent No. 6,094,659, issued to Bhatia (hereinafter referred to as "Bhatia"). This ground of rejection is respectfully traversed for failure of the Examiner to make a *prima facie* case of obviousness as specified by MPEP 2143.

The first showing required of MPEP 2143 is that of "motivation". In her only apparent attempt at showing motivation, the Examiner states:

It would have been obvious to one of ordinary skill at the time of the invention to have combined Bhatia with Cool ICE

User's Guide because Bhatia is concerned with informing a user of a failure condition through a set of predefined messages and a status message is an important message that can be implemented with a high level language for communication. (Emphasis added)

This statement is clearly erroneous. Bhatia is concerned with a "Web Server for use in a LAN Modem"¹. Therefore, the only "failure condition or other operational event" of concern to Bhatia is directly associated with the LAN Modem. The Abstract provides in part:

The resulting page informs a user stationed at the workstation of a failure condition or other operational event that then occurred at the LAN modem. (Emphasis added)

Cool ICE makes no mention of a LAN (LOCAL AREA NETWORK) or LAN modem. Therefore, Applicant strongly disagrees that anyone practicing Cool ICE would have any motivation to employ a LAN or LAN modem. Such an element would be clearly superfluous to the use of Cool ICE.

Having failed to show any motivation for the alleged combination, the Examiner completely ignores her obligation to show reasonable likelihood of success. Most probably she has failed to do so because there is not reasonable likelihood of success.

MPEP 2143.03 requires that all claim limitations must be taught or suggested by the alleged combination. It reads in part:

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d. 981, 180 USPQ 580 (CCPA 1974), "in judging the patentability of that claim against the prior art". *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). (emphasis added)

The Examiner has failed to meet the requirement to show all claim limitations within the alleged combination, because she has at least not considered "all words in a claim" as specifically required by MPEP 2143.03.

Claim 1, for example, is limited by transferring "an unavailability message as an HTML display page to said user terminal

¹See Title.

in response to said service request when said data base management system is unavailable to receive and respond to said service request". The Examiner admits that Cool ICE does not contain this limitation. Therefore, she clearly erroneously states:

Bhatia teaches this feature.

This statement is clearly erroneous in view of the disclosure of Bhatia which has no "unavailability message", no "response to said service request", no "data base management system", and no "unavailable to receive and respond to said service request". The Examiner is respectfully reminded that MPEP 2143.03 requires "**All words in a claim must be considered**". Nevertheless, she has clearly ignored much of the language and therefore the basis of claim 1.

Instead of examining claims 6-22, which have differing statutory and judicial bases of patentability as well as differing claim limitations, the Examiner simply states:

The limitations of claims 6-22 have been addressed above in claims 1-5, except for the following: transferring an unavailability message to said user terminal if said determining step determines data base management system is not currently capable of honoring said service request [note: Bhatia Figure 4B; col. 7 lines 4-26 protocol may be event-specific; col. 24 lines 23-39].

In addition to this statement being legally and grammatically incorrect, to the extent understandable, it is clearly erroneous. Furthermore, the statement is legally irrelevant, because it does not address the language of any claim or limitation thereof. The Examiner is prohibited by MPEP 2143.03 from disregarding Applicants' claimed invention. The rejection of claims 6-22 should be reversed as being improperly examined.

Please charge any deficiencies or credit any overpayment to
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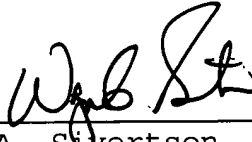
Respectfully submitted,

Niels Gebauer

By his attorney

Date

Aug 30, 2006



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